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09/866,512	05/24/2001	Thomas J. Meade	A-58634-7/RFT/RMS/RMK	4765

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 05/30/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/866,512

Applicant(s)

MEADE ET AL.

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/13/02; 10/30/02; and 2/28/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 13-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 4.                      6) ☐ Other:

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the following:
  - a. Paper No. 7, filed 3/13/02, wherein the specification was amended; claims 1-11 were canceled; and claims 12-28 were added.
  - b. Paper No. 15, filed 10/30/02, wherein claim 24 was canceled; claims 13-15, 17, 19, 21-23, 25, 27, and 28 were amended; and claim 29 was added.
  - c. Paper No. 17, filed 2/28/03, wherein claim 29 was amended and claim 30 was added.

**Note:** Claims 12-23 and 25-30 are pending.

## **APPLICANT'S INVENTION**

2. Applicant's invention is directed to a composition and use thereof comprising a polymer, a linking group, and at least one MRI agent having at least one chelator comprising a paramagnetic ion and a blocking moiety.

## **RESPONSE TO APPLICANT'S RESTRICTION**

3. Applicant's election with traverse of Group IV (claims 12-23 and 25-30) in Paper No. 17, filed 2/28/03, is acknowledged. The traversal is on the ground(s) that the restriction requirement mailed on 9/27/02, Paper No. 14, required Applicant to elect from various species designated as Groups I-V and contained a Group VI which was not directed toward any specific species. Thus, Applicant interpreted Group VI as if they would be allowed to prosecute claims directed to a generic peptide-blocking

moiety. Hence, Applicant initially elected Group VI and did not point out a blocking moiety as requested in the office action mailed 9/27/02. In response to Applicant not electing a blocking moiety, the Examiner mailed a non-responsive office action requesting that Applicant identify the blocking group. As a result, Applicant changed the elected Group VI to Group IV and asserts that the election of a blocking group by the Examiner is erroneous and that the Examiner forced the Applicant to elect a species within the genus of peptide blocking moieties. This is found non-persuasive because the Examiner did not force Applicant to elect from Groups I-V. Applicant had the opportunity to elect (and initially did) Group VI. However, as set forth in the restriction requirement, the Examiner set forth the election of species conditions and specifically requested that Applicant identify the blocking moiety. It should be noted in the restriction requirement that the Examiner stated "Applicant is respectfully requested to elect a species for search purposes. In particular, the species should include a blocking moiety (if Group VI is selected), chelator(s), metal(s), linking groups, and a polymer". Hence, Applicant was aware that a blocking moiety should be identified if Group VI was elected. The restriction requirement is still deemed proper and is therefore made FINAL.

**Note:** The search has not been extended beyond Applicant's elected Group IV directed to compositions and uses thereof comprising a polymer, at least one chelator, a linking group, and a PMALWMR blocking moiety.

## 112 REJECTIONS

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-23 and 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-23 and 25-30: The claims as written are ambiguous because they depend upon canceled claim(s) 1 and/or 2 and/or 3. However, all claims were examined as if they read upon independent claim 12.

## SPECIFICATION

6. The disclosure is objected to because of the following informalities: Applicant is respectfully requested to update and modify the continuing data in the first paragraph of the specification. The continuing data should be consistent with that appearing on the file wrapper.

Appropriate correction is required.

## COMMENTS/NOTES

7. Claims 12-23 and 25-30 are distinguished over the prior art of record; however, Applicant MUST address and overcome the 112 rejections above. In particular, the prior art neither anticipates nor renders obvious a composition and uses thereof


comprising a polymer, at least one chelator, a linking group, and a PMALWMR blocking moiety.

8. Applicant is respectfully requested to cancel all subject matter not directed to the elected invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones  
Primary Examiner  
Art Unit 1616

May 29, 2003